

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL S. WIGGINS
AND
REUBEN H. GRINSTEIN

Appeal No. 1999-0781
Application No. 08/236,328

ON BRIEF

Before PAK, OWENS, and TIMM, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-4, 6-25, 28, and 29, which are all of the claims pending in this application. According to the Answer, claims 1-4, 6-25, and 28 presently stand allowed (Answer at 2). Therefore, this appeal is limited claim to 29.

BACKGROUND

Appellants' invention relates to polymeric compounds which are useful as thickeners for aqueous compositions, especially emulsion polymer latexes (specification at 1, ll. 7-8). Claim 29, the only claim on appeal, is illustrative:

29. A polymer composition comprising a backbone of poly- (acetal- or ketal-polyether) which has ends that are capped with hydrophobic groups independently selected from the group consisting of alkyl groups having from about 9 to about 15 carbon atoms, and alkylphenyl groups wherein the alkyl groups have from about 6 to about 10 carbon atoms.

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Lenke et al. (Lenke)	3,997,613	Dec. 14, 1976
Kelsey	5,093,460	Mar. 3, 1992

Claims 29 stands rejected under 35 U.S.C. § 103 as being unpatentable over Kelsey in view of Lenke. We reverse substantially for the reasons presented by Appellants and add the following for emphasis.

OPINION

The Examiner finds that Kelsey discloses polyketal polyethers end capped with an end capping reagent such as methyl chloride (Answer at 3). The difference between Kelsey's polymer and the claimed polymer is that the claimed polymer must be end capped with with alkyls having from about 9 to about 15 carbon atoms. Therefore, the Examiner looks to Lenke which, according

to the Examiner, discloses polyacetal and polyketal capped with monoalcohols having the required number of carbon atoms (Answer at 3). The Examiner concludes that

it would be [sic: would have been] obvious to one of ordinary skill in the art to end cap the Kelsey polyketal polyethers with monoalcohols having 9 to 15 carbons such as decanol or dodecanol. The motivation is that Kelsey teaches end capping of the claimed polyketal polyether and Lenke teaches end capping of polyketal with the required alcohol having 9 to 15 carbons.

The fact that Lenke teaches a particular end cap on a similar but different polymer in and of itself is not a reason, suggestion or motivation to use that end cap on the polymer of Kelsey. “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The Examiner must identify specifically the principle, known to one of ordinary skill in the art, that suggests the claimed combination. *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). No principle that suggests incorporating the longer alkyl end cap into the polymer of Kelsey is identified.

As pointed out by Appellants, Kelsey exemplifies the molding of a polyketal polyether to give a clear tough plaque (Example 9), but otherwise discloses no specific utility for the polymers (Reply Brief at 2). On the other hand, the polymers of Lenke are to be used as plasticizers for polymeric materials (Reply Brief at 2-3; see also Lenke at col. 1, ll. 12-14). The Examiner provides no basis to believe that one of ordinary skill in the art would find the end cap of Lenke’s plasticizer useful in the polymer of Kelsey.

We conclude that the Examiner has failed to establish a *prima facie* case of obviousness with respect to the subject matter of claim 29.

CONCLUSION

To summarize, the decision of the Examiner to reject claim 29 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED

CHUNG K. PAK
Administrative Patent Judge

TERRY J. OWENS
Administrative Patent Judge

CATHERINE TIMM
Administrative Patent Judge

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